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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/696,295	MORRISROE ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28 and 31-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is responsive to amendment, filed August 5, 2008. Claims 1-28 and 31-33 are still pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "combining an ad input file with a conduit file to create an integrated ad file containing both the ad input file and the conduit file contents, wherein the ad input file identifies the content of the ad and the conduit file comprises ***computer code to provide the ad*** and to identify tracking data for the ad".

Applicant's specification teaches the web page includes html code (ad.html) 202 for loading an integrated ad file 204 from the ad server 102. Further the specification teaches the integrated file 204 reflects the integration or combination of two separate files: an ad input file, primary including the contents of the ad, and a conduit file, primarily including code for tracking the ad. (see [0028]). Further the specification teaches fig. 5 illustrates operations performed by the portal 100 (e.g., and administrator 108) in creating the integrated ad file 204 to be served via the ad server. As illustrated the portal 100 uses a merger tool 502 to combine the content of an ad

input file 504 provided by the advertiser 110 with the content of a conduit file 506 created by the portal ... *the conduit file 506 contains code for tracking the ad* (see [0038]).

The specification teaches the conduit file includes a code of tracking but does not teach the conduit file ***includes a code to provide the ad***.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by of Solbright White Paper; "The Inside Edge on Rich Media Partnership Series"; March 2001, (herein after Solbright).

Regarding claim 1, Solbright teach integrating an input file (Flash ad) and conduit file (tracking code) *using a merge tool to automatically* create and an integrated file containing both the ad input file and the conduit file *prior to serving the integrated ad file from a computer;* (creating **an HTML wrapper file** that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad) (see page 18); wherein the conduit file comprises of computer code for tracking data for the ad, and serving the integrated ad file from a computer to provide the ad (see pp 17-19);

Regarding claim 4, Solbright teaches the use of Macromedia Flash; wherein the ad is Flash ad and the files are "swf" files (see pp 17 see also the sites for the "Macromedia's Rich Media Tracking Kit" cited in White Paper, page 17)).

Regarding claims 7-10, Solbright teaches the ad including one or more actions for linking to one or more web pages where in the integrated ad file includes html code loading a JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file and tracking identifier; the html code including a variable and the conduit file includes code that determined where the ad opens in a parent window or new window based on the variable (see pp 18-20, see also www.macromedia.com/solutions/richmedia/tracking/advertising_guide/).

Regarding claim 33, Solbright teaches the ad is provided to a user computer via the Internet and combining of the files is in response to receiving a request for a Web page and serving the integrated ad file as par of the web page (see pp 17-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 5, 6, 11-28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solbright White Paper; "The Inside Edge on Rich Media Partnership Series"; March 2001, (herein after Solbright) in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, Solbright does not explicitly teach receiving a modified ad file or conduit file. Solbright teaches designers creating their ads and developers or programmers adding the tracking string after the ads are created. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to known that the designer or programmers of Solbright would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.

Regarding claims 5 and 6, Solbright does not explicitly teaches the input file includes an empty movie object and inserting the conduit file in the empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name. However official notice is taken that well known in the art of movie clip create empty movie clip and to assign a predetermined name. It is well known to create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the empty clip as a placeholder for external file such as the tracking data, if the ad is a movie clip.

Regarding claims 11, 12, 15-21, 24-27, Solbright teaches identifying a first file (flash ad); identifying a second file (tracking information); wherein the first file specifies ad content code and the second file contains ad-tracking code; creating an ad file including computer code for providing the ad; wherein the first file specifies ad content code and the second file contains an ad-tracking code; html code loading ad file (third file); third file including one or more buttons; creating the (see pp 17-20). Solbright does not explicitly teach identifying a placeholder (an

empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. However official notice is taken that is old and well known in the art of programming to create empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a placeholder for external files such as the tracking data to be inserted in it, if the ad is a movie clip.

Regarding claims 31 and 32, Solbright teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 17-20).

Response to Arguments

Applicant's arguments filed August 5, 2008 have been fully considered but they are not persuasive.

Applicant asserts that referring to paragraph 32 (n.b., the paragraph numbering used herein corresponds to that used in the present application's publication, U.S. Publ. No. 2004-0117259) of the present application, the integrated ad file 204 includes code (*incorporated from the conduit file also described below*) that pulls the value of the "targID" variable and, depending on the value of the variable, either provides the ad in a new window or in the same window. However the specification in paragraph 32 teaches determining whether or not a user's link to another web page opens... involves the integrated ad file 204 pulling the "targID" variable specified **in the html code 202**. According to the specification the conduit file includes only a

code used for tracking and the html code 202 is used for loading the integrated ad file 204. Applicant again argues that the cited portion of Solbright requires that someone, such as a programmer, modify the ad file to include the "getURL(clickTag)" action in the ad file. See, for example, the process described at page 18 of Solbright. Applicant also asserts the Examiner concedes that Solbright requires that a Flash ad be manually edited. Applicant further argues in order to track an order to track an ad, for each Flash ad file, Solbright's approach requires that a programmer edit the ad file to add the getURL action code to the Flash ad file. Examiner respectively disagrees.

Applicant again argues that it is clear that Solbright suffers from the same conventional shortcomings described in the background of the present application and discussed above. As indicated in the last office action Solbright teaches to ease the burden of this process the MFAA advises developers to **create an editable HTML wrapper** for the ad that uses … (see page 17). Solbright teaches creating **an HTML wrapper file** that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad. Solbright teaches each publisher will need to modify **this file** (the HTML wrapper) to insert their own, unique tracking code. This file (the HTML wrapper) should also have the appropriate sniffer code to detect the presence of the Macromedia Flash Player, and to display the alternate GIF ad if necessary. As indicated before Examiner point out that the article is referring to the HTML wrapper file being modified not the Flash ad file.

Solbright also shows a brief explanation of the <EMBED> string (tracking string syntax) as ("EMBED SRC="/imageserver/banner, swf?clickTAG=http://adserver:com/trackingstring? http://www.advertiser.com/destination.html"). Further Solbright teaches that there are a number

of parts to this embedded tracking string; the first part of the tracking string /imageserver/banner.swf is used to identify the location of the Macromedia Flash file on the publisher's image server (*the advertiser will not know this string in advance),* the variable (clickTAG) is used to identify the tracking location (http://adserver.com.trackingstring) on the publisher server that will log the number of clicks on the ad. (see page 18).

Applicant keep arguing that while the Examiner contends that "tracking code" corresponds to the claimed conduit file, as is clear from the concessions made by the Examiner in the Office Action discussed above, tracking code *per se* cannot and does not disclose or even suggest a conduit file, let alone a conduit file which is combined with an ad input file to create an integrated ad file as is recited in Claim 1. Examiner would like to point out that, according to applicant's disclosure the conduit file "primarily includes code used in tracking the ad". If applicant is claiming that the conduit file is more than the code used for tracking the ad, Applicant's specification does not clearly teach such feature. According to applicant's invention the advertiser creates the content of the ad (504), and the portal uses the merge tool 502 to combine the content of ad input file (provided by the Advertiser) and conduit file (tracking code created by the portal). Therefore, the tracking code are created and added to the ad file at the server, same as the prior art; the same as creating an HTML wrapper file that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad and then each publisher will need to modify this file (wrapper file) to insert their own, unique tracking code (same as applicant merge file to add the tracking code (conduit file)).

Applicant again argues that while the Examiner contends that "tracking code" corresponds to the claimed conduit file, as is clear from the concessions made by the Examiner in the Office Action discussed above, tracking code *per se* cannot and does not disclose or even suggest a conduit file, let alone a conduit file which is automatically combined with an ad input file using a merge tool to create an integrated ad file as is recited in Claim 1. Examiner again points out that according to applicant's disclosure the conduit file is a code for tracking the ad (see for example par. [0028][0038]). Applicant disclosure does not teach if the conduit file includes more than the tracking code, further applicant in his argument provides no support to indicate that the conduit file is more than mere tracking code. Therefore, in light of applicant's disclosure the conduit file is a file that contains cod for tracking the ad (see par. [0038]). Applicant argues that there is nothing in Solbright that corresponds to the claimed conduit file, and/or combining the claimed conduit file and an ad input file to create an integrated ad file. It follows then that nothing in Solbright corresponds to creating a modified integrated ad file by combining a modified ad input file with a conduit file (Claim 2) or by combining an ad input file with a modified conduit file (Claim 3).

Solbright teaches as follows: (see page 17, 18)

This enables the publisher to provide the specific performance metrics for each placement of the ad on their site. Until now, advertisers and web publishers followed laborious and costly processes for each ad placement to get the correct tracking string inserted:

1. The media buyer contacted the site's production staff to get the appropriate tracking string.

2. The media buyer transferred the tracking string information to the Macromedia Flash developer.

3. The developer created a unique copy of the Macromedia Flash source file (FLA) and hard-coded the tracking string into the creative.

4. The developer delivered the appropriate version of the Macromedia Flash ad (SWF file) to the media buyer.

5. The media buyer sent the creative to the publisher.

6. **If the right version of the ad was sent to the publisher and the tracking string was inserted correctly,** the ad would go live with the performance metrics being captured by the ad server. Otherwise, incorrect metrics, if any, would be recorded, skewing the results of the campaign. **If the publisher realized the mistake, the process would repeat, beginning at Step 2, until the correct file was sent back to the publisher.**

To help ease the burden of this process, the MFAA advises developers to create an editable HTML wrapper for the ad that uses the <OBJECT> and <EMBED> tags to pass through the appropriate parameter for the tracking of the getURL action command within the complied SWF file.

As indicated above Solbright teaches before the MFAA advice, the publisher or the program would send a corrected (modified) ad or tracking string until they get it right. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to know that the publishers and programmers in Solbright would still modify the ad or the tracking code use the HTML wrapper to integrate the ad and the tracking code.

Examiner took "Official Notice" for a well know feature of create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Regarding the "Official Notice" taken by the Examiner applicant argues as follows:

> With regard to the Official Notice taken in the Office Action, the Applicant respectfully submits, as is clearly set forth in MPEP § 2144.03, that Official Notice is only appropriate in a limited number of circumstances and should only be taken where the

> facts are capable of instant and unquestionable demonstration as being well known or common knowledge. It should not be used simply as a matter of convenience. The Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain her rejection of the claims based on Officially Noticed facts, the Applicant respectfully requests that the Examiner provide documentary support for each fact Officially Noticed. The requested documentary support is particularly important in view of the Examiner's own admission in her grounds for rejecting Claims 2, 3, 5, 6, 11 to 28, 31 and 32, in which the Examiner concedes that the only documentary evidence of record relied on to make the § 103(a) rejection of these claims fails to teach, suggest or disclose multiple elements of these claims.

Nowhere in applicant argument is indicated that the feature of creating an empty movie clip using Macromedia Flash, one that contains no data or graphic content, in order to load external files (JPGS or SWF) is not well know or that applicant is not aware of the know feature. Since Applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Allowing bald statements such as " requesting the Examiner to provide documentary evidence of any official noticed" to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the process of establishing a rejection of a well known facts. Therefor, the presentation of a reference to substantiate the Official Notice is not deemed necessary and the examiner's taking of the Official notice has been maintained.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kocol (US 20020116494) teaches automatically embedding a tracking code in via a simple program that inserts such code before the end body tag, so the developers of the web site need not change the way they write or code their Web pages and upload them to a content provider server (see [0045]).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622